



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/889,325

12/31/2001

Saori Kitao

04276.00003

2310

22907

7590

04/06/2005

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,325

Applicant(s)

KITAO ET AL.

Examiner

Christopher H. Yaen

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 3282005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Exhibit A.

DETAILED ACTION

Re: Kitao *et al*

Priority Date: 19 January 1999

1. The amendment filed 11/17/2004 is acknowledged and entered into the record. Accordingly, claim 15 is newly added.
2. Claims 1-15 are pending, claims 1-6 and 8-14 are withdrawn as being drawn to a non-elected invention.
3. Claims 7 and 15 examined on the merits.

NEW ARGUMENTS

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Fu *et al* (US Patent 6,090,620). Claim 7 is drawn to a diagnostic agent which contains an antibody which is capable of binding to RecQ4 helicase as shown in SEQ ID No: 4. Fu *et al* teaches an antibody that is "capable" of binding to SEQ ID No: 4 (see exhibit A and col. 3, lines 8-17, for example). Because it is well known in the art that the minimum requirement for an antibody epitope is 6 contiguous amino acids (evidenced by Harlow

Art Unit: 1642

Antibodies: A laboratory Manual, 1998; Chapter 5 page 76), in the absence of evidence to the contrary the antibody taught by *Fu et al* would be "capable" of binding to RecQ4 as claimed. Moreover, the office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the applicant to prove that the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in a paper filed 11/17/2004.

Conclusion

No claim is allowed.

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1642

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen
Art Unit 1642
March 28, 2005



JEFFREY SIEW
SUPERVISORY PATENT EXAMINER
3/29/05

Exhibit A

QY 771 TAAFGWGLDRPDVRAVLAHLGLPPSFESYVOAVGRAGRDGPAPHCHLFLPOGEDLRELR 830
 DB 301 TAAFGWGLDRPDVRAVLAHLGLPPSFESYVOAVGRAGRDGPAPHCHLFLPOGEDLRELR 360
 QY 831 H 831
 DB 361 H 361

RESULT 5
 US-08-781-891-75
 Sequence 75, Application US/08781891
 Patent No. 6090620

GENERAL INFORMATION:
 APPLICANT: Fu, Ying-Hui
 APPLICANT: Oshima, Junko
 APPLICANT: Mulligan, John T.
 APPLICANT: Schellendberg, Gerald D.
 TITLE OF INVENTION: GENE AND GENE PRODUCTS RELATED TO
 TITLE OF INVENTION: WERNER'S SYNDROME
 NUMBER OF SEQUENCES: 209
 CORRESPONDENCE ADDRESS:
 ADDRESSEE: SEED and BERRY LLP
 STREET: 6300 Columbia Center, 701 Fifth Avenue
 CITY: Seattle
 STATE: Washington
 COUNTRY: USA
 ZIP: 98104-7092

COMPUTER READABLE FORM:
 MEDIUM TYPE: Floppy disk
 COMPUTER: IBM PC compatible
 OPERATING SYSTEM: PC-DOS/MS-DOS
 SOFTWARE: Patent in Release #1.0, Version #1.30

CURRENT APPLICATION DATA:
 APPLICATION NUMBER: US/08/781,891
 FILING DATE: 27-DEC-1996
 CLASSIFICATION: 800

ATTORNEY/AGENT INFORMATION:
 NAME: No. 6090620cendburg Ph.D., Carol
 REGISTRATION NUMBER: 39,317
 REFERENCE/DOCKET NUMBER: 240052.419
 TELEPHONE: (206) 682-4900
 TELEFAX: (206) 682-6031
 INFORMATION FOR SEQ ID NO: 75:
 SEQUENCE CHARACTERISTICS:
 LENGTH: 607 amino acids
 TYPE: amino acid
 STRANDEDNESS: single
 TOPOLOGY: linear

US-08-781-891-75

Query Match 9.8%; Score 632.5; DB 3; Length 607;
 Best Local Similarity 37.6%; Pred. No. 1.6e-42;
 Matches 164; Conservative 63; Mismatches 134; Indels 75; Gaps 15;

QY 474 EOLGQAPRPGQERAVRILISGISTLVLPFGAGKSLCYDALLYSRRSPCLITLVNPL 533
 DB 18 ETFGQOFRPGQERAVRILISGISTLVLPFGAGKSLCYDALLYSRRSPCLITLVNPL 73
 QY 534 LSLMDQVSGLP-CLKAACIHSGMTKQRESYVQKIRAAQVHVLMTPREALVAGAGLPP 592
 DB 74 ISLMQOVQOLQANGVAAACINSTQREOQLEVTGCRGQIRLYIAPERLMDNPL 133
 QY 593 AAOPLVAPACITBEACLSQWSNPRCYLRVCKVLERMGVACFLGLTATATRTASDV 652
 DB 134 LAHNPVTLA-VDEARCTSQWGHDFREYALGQ-LRQRPFLPFWALATATADTRQDI 191
 QY 653 AOHRAVAEBPLDGPAPVPTNLHLSVSMRDTDOALLTLQGRFQNDLSI----- 703
 DB 192 VRLIG-----LNPPL-----IGIS-SFDRNIRYMLM-----EKFKPLDQIMRYVQERG 235

QY 704 ---IICNRREDTERIALRLTCLHAAVPGSGRAPPTTAAVHAGWCSRRERRVQRAF 760
 DB 236 KSGIICNSRAKVEDTAAAL-----OSKGISAAVHAGLENNVRADVQKRF 281
 QY 761 MGOGLRVVAVTAFQWGLDRPDVRAVLAHLGLPPSFESYVOAVGRAGRDGPAPHCHLFL-- 818
 DB 282 QRDDLQIVAVTAFQWGLDRPDVRAVLAHLGLPPSFESYVOAVGRAGRDGPAPHCHLFL-- 818
 QY 819 -----QPOGEDLRELRH-----VHADSTDFLAVRLV-----QVFPACTC- 855
 DB 342 ADWAMLRCLERKPOQO-LQDIERHKLNMGAFAEAQTCRLVLNYPFGERGQPCGNC 400
 QY 856 TCTRPSEOGAVGGE 871
 DB 401 ICIDPFPQYDGTDAQ 416

RESULT 6
 US-09-618-166-75